

9 providing an order address location to a user for a reseller that sells
10 the consumable; and
11 placing an order for the consumable with the reseller using the
12 personal computer.

19. The method of claim 18 wherein placing the order comprises
automatically placing the order for the consumable in response to notifying the
user.

20. The method of claim 18 wherein, prior to placing an order,
querying a user to authorize placing the order with an identified reseller.

REMARKS/ARGUMENT

In the Office Action, the Examiner noted that claims 1-20 are pending in the application and that claims 1-20 are rejected. By way of a telephone conference call, the Examiner confirmed that paragraph 2 of the present Office Action only rejects claims 1-13 under 35 U.S.C. §102(b), but that the Examiner intended to reject all of the present claims 1-20 under 35 U.S.C. §102(b). Accordingly, such rejection of claims 1-20 has been presumed in preparing the present response. By this response and request for reconsideration, claims 1-20 remain pending in this application and all are believed to be allowable over the prior art of record.

Rejections Under 35 U.S.C., §102

Claims 1-13 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by *Gershman, et al.* (U.S. Patent No. 6,199,099). The Examiner summarily rejects all of claims 1-13 with the following statement:

Gershman et al. teaches a consumable order assistance system for computer peripheral devices such as those

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Amendment A

shown in figure 7, 24 and 26. The system includes a personal computer having a web browser; see figure 24. The above figures show at least one computer peripheral device having a messaging system such as the speakers or the display touch screen or the e-mail, laptop, mobile telephone, pocket organizer, etc....

Gershman et al. also discloses a communication link signal coupling the personal computer with a provider of a consumable of the computer peripheral device via the web and a consumable order assistance computer program/software provided on the personal computer and configured to receive notification from the peripheral device via a messaging system of a need to order a consumable and alert a user of the personal computer of the notification and provide an order location to the user. See column 2, lines 40-55, column 4, lines 45-55, column 10, lines 35-64, column 30, lines 1-45, column 31, lines 29-55, column 35 and half of column 36, column 38, column 39, lines 25-50, column 52, lines 1-40. Also see figure 10A and the abstract.

In order to establish a *prima facie* case of anticipation, the Examiner must provide (1) a single reference, (2) that teaches or enables, (3) each of the claimed elements (arranged as in the claim), (4) expressly or inherently, (5) as interpreted by one of ordinary skill in the art. Here, Applicants traverse the Examiner's assertion as the Examiner has not established a *prima facie* case of anticipation. Instead, the Examiner appears to loosely apply *Gershman, et al.* to the limitations found in claim 1.

In order to properly formulate an anticipation rejection under 35 U.S.C. §102(b), 35 U.S.C. §102(b) states:

A person shall be entitled to a patent unless (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States,....

U.S. Patent No. 6,199,099 B1 to *Gershman, et al.* was issued and published on March 6, 2001. The date of application for the present patent

application was November 10, 2000, which precedes the publication date for the cited prior *Gershman, et al.* reference. Accordingly, the present anticipation rejection under 35 U.S.C. §102(b) is improper and removal of such rejection is respectfully requested.

Additionally (assuming the *Gershman, et al.* reference had been proper), the *Gershman, et al.* reference does not teach each of the claimed elements as anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. This has not been shown in *Gershman, et al.* It is well known that anticipation will not be found where a prior art reference is lacking or missing a specific feature or the structure of the claimed invention. In such cases, additional prior art is necessary to show the specific arrangement or structure of the claimed invention when novelty is present. Accordingly, Applicants attack the Examiner's anticipation rejection as being improper because each of the claimed elements are not shown in the improperly cited 35 U.S.C. §102(b) *Gershman, et al.* reference.

Accordingly, Applicants respectfully request allowance of the present claims or, in the alternative, the identification of additional prior art or specific teachings within the existing art in a non-final Office Action which discloses the alleged teaching suggested by the Examiner. Here, the Examiner has failed to provide a single reference that teaches or enables each of the claimed elements of claims 1-20 (arranged as in the claim), expressly or inherently, as interpreted by one of ordinary skill in the art. Furthermore, Applicants do not believe that the Examiner has properly applied *Gershman, et al.* (assuming it was patented or described in a printed publication more than one year prior to the date of application of the present patent effort, which it was not). Because of the manner in which the Examiner attempted to apply anticipation using *Gershman, et al.*, Applicants respectfully remind the Examiner that, in order to determine anticipation, it must be viewed by one of ordinary skill in the art as asserted by the Federal Circuit:

There must be no difference between the claimed invention and the referenced disclosure, as viewed by a person of ordinary skill in the field of the invention.

See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991). Even furthermore, the Federal Circuit has stated:

An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that the existence was recognized by persons of ordinary skill in the field of the invention.

See *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 48 USPQ 2d 1321, 1328 (Fed. Cir. 1998).

Here, the elements described in independent claim 1 call for a consumable order assistance computer program that receives "a notification from a computer peripheral device via a messaging system of a need to order a consumable, alert a user of the personal computer of the notification, and provide an order location to the user for the consumable". Applicants could find nowhere within *Gershman, et al.* any such elements. The Examiner is also reminded that claims 2-20 contain additional limitations which need to be addressed and cited by the Examiner in formulating an anticipation rejection. It appears that the Examiner did not cite these limitations when making the inappropriate anticipation rejection using *Gershman, et al.* For example, claim 2 recites:

...wherein the consumable order assistance computer program is further configured to collect a series of notifications and summarize the series of notifications for one or more computer peripheral devices.

Nowhere does the Examiner address these features in the present §102 rejection.

Accordingly, Applicant asserts that the Examiner has not established a *prima facie* case of anticipation with respect to claims 1-20. Withdrawal of this rejection is respectfully requested.

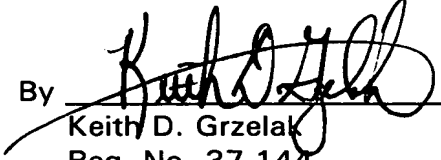
CONCLUSION

For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview before issuance of any such subsequent action.

Respectfully submitted,

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S/N: 09/710,366
Case: 10003235-1
Amendment A

**PATENT APPLICATION
DOCKET NO. 10003235-1**

**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

INVENTOR(S): Robert E. Haines, Mark A. Harper, Kenley Hinrichs, Mary B. Baumunk, Jodi Goettemoeller, and Sharon Whaley

SERIAL NO.: 09/710,366 **GROUP ART UNIT:** 3625

FILED: November 10, 2000 **EXAMINER:** Jeanette E. Chapman

SUBJECT: "Reorder-Assistance Functionality Levels"

**VERSION WITH MARKINGS TO SHOW CHANGES MADE
IN RESPONSE TO OFFICE ACTION DATED JULY 16, 2002**

In the Specification:

The replacement specification paragraphs incorporate the following amendments. Underlines indicate insertions and ~~strikeouts~~ indicate deletions.

The paragraph beginning at line 7 on page 11 has been amended as follows:

Figure 2 illustrates a first environment 100 for which consumable order assistance system of Figure 1 can be configured to have a first set of functionality levels for a home or single connection environment. As shown in Figure 2, web information 46 is provided via the Internet 23. The computer peripheral device 14, comprising a printer 16, is interconnected with a local bus (not shown) with a PC 12. One or more users 48 of PC 12 interact with peripheral device 14 to obtain information on consumable

levels, media levels and types, warnings and/or notifications, job assurance, and printer capabilities. A decision maker 50, in one case one of the users, also interacts with peripheral device 14 via PC 12. In one case, decision maker 50 comprises a credit card holder who is going to act as a purchaser in order to purchase consumables over Internet 23 from a reseller. Decision maker 50 interacts with peripheral device 14 to determine when to replace consumables, what consumables to replace, alternative parts that are needed, issue urgency, proactive warning of next issue(s), printer model, serial number, etc., pending maintenance notification, usage and/or depletion rate, the last reseller utilized, and other reseller sources. In response to interacting with peripheral device 14 and connecting with Internet 23, decision maker 50 submits an external order 52 utilizing the system of this invention. It is understood that web information 46 comprises part numbers for consumables, alternative part numbers for consumables, and selection information for a reseller.

The paragraph beginning at line 7 on page 12 has been amended as follows:

Figure 3 illustrates another environment 200 for which consumable order assistance system of Figure 1 can be configured to have a first set of functionality levels for an unmanaged, small office environment. More particularly, users 48, each on a PC 12, interact in one-to-one bi-directional communication with a plurality of

peripheral devices 14, 114, and 214. Additionally, the service provider 150, such as a small office maintainer and/or administrator 151 or a printer buyer 152, communicates via one or more PCs 12 bi-directionally to poll computer peripheral device 114 which comprises a Legacy printer. Service provider 150 receives web information 46 from the Internet 23. Furthermore, service provider 150 receives event push information from peripheral device 14 which comprises a laser printer having an embedded web server. Furthermore, service provider 150 receives additional event push information from computer peripheral device 214 comprising a multi-function peripheral device (MFP) having an embedded web server therein.

The paragraph beginning at line 14 on page 13 has been amended as follows:

Figure 4, provided by combining Figures 4A and 4B, illustrates a first third environment 300 for which consumable order assistance system of Figure 1 can be configured to have a first set of functionality levels for an enterprise environment. More particularly, an enterprise environment solution comprises a centralized management database provided on a server 212. Web information 46 is provided to database 210 by polling data from Internet 23. More particularly, web information 46 comprises consumable part numbers, alternative consumable part numbers, and information for selecting a reseller. Users 48 each use a PC 12 to communicate on a one-to-one relation bi-directionally with computer peripheral devices 14, 114,

and 214. As was the case with the environment depicted in Figure 3, computer peripheral device 14 comprises a printer having an embedded web server. Computer peripheral device 114 comprises a Legacy printer. Furthermore, computer peripheral device 214 comprises a multi-function peripheral (MFP) having an embedded web server.

In the Claims:

No claims have been cancelled or added herein.

Claim 10 has been amended as follows (deletions are ~~struck through~~ and additions are underlined):

1 10. (Amended) A computer-implemented system which implements
2 a program in which consumable components of computer peripheral devices are
3 replenished, the system comprising:

4 a notification system that alerts a user of a personal computer that
5 they need to order a consumable for a computer peripheral device associated
6 with the personal computer;

7 a facilitation system that provides a communication link with a reseller
8 of the consumable; and

9 at least one from a list of a consolidation system for consolidating a
10 plurality of orders, an authorization system for confirming that a user is
11 authorized to place ~~and~~ an order for the consumable, and an order assistance
12 system that places an order for the consumable.

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